

10 PERSONALWEB TECHNOLOGIES
11 LLC, et al.,
12 Plaintiffs,
13 v.
14 INTERNATIONAL BUSINESS
15 MACHINES CORPORATION,
16 Defendant.

Case No.16-cv-01266-EJD (NC)

**ORDER ON DISCOVERY
MOTIONS, DKT. NOS. 183, 189**

Re: Dkt. Nos. 183, 189

17 Defendant IBM moves to (1) amend its invalidity contentions to incorporate
18 additional charts; and (2) to strike paragraphs of PersonalWeb's expert report as untimely
19 disclosed. The patent local rules of this district require early disclosure of each party's
20 infringement and invalidity contentions. Patent L.R. 3-1, 3-3. In this case, the disclosures
21 were exchanged in 2014, and the parties sought to amend them as necessary.

22 In the first-filed motion, IBM argues that in its invalidity disclosures, IBM
23 incorporated by reference several prior art references used in other litigation and
24 proceedings. After PersonalWeb objected to certain of those incorporated reference in
25 IBM's invalidity report as not previously disclosed, IBM moved to amend its contentions
26 to "clarify" the full set of prior art references.

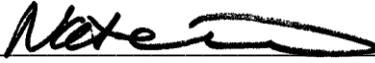
27 In the second-filed motion, IBM argues that PersonalWeb failed to disclose some of
28 the opinions relied upon their opening expert infringement report. PersonalWeb admits
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1 that it made a typographical error in one sentence of its 2014 contentions. Additionally,
2 PersonalWeb argues that its infringement analysis is within the scope of the theories
3 disclosed in the infringement contentions.

4 At the hearing, the Court asked the parties to address the impact of the opinions,
5 prejudice in permitting the opinions, and whether additional discovery would be needed.
6 The Court concludes that the parties' infringement contentions are sufficient to have put
7 each other on notice of the theories disclosed in the expert reports. Additionally, no party
8 stated that it needed additional fact discovery to respond to the "new" theories. Finally, at
9 this stage, the parties still have an opportunity to address the theories presented in the
10 opening reports through rebuttal expert reports and expert depositions. Consistent with
11 this conclusion, the Court GRANTS IBM's motion to amend its invalidity contentions and
12 DENIES IBM's motion to strike expert testimony of Dr. Reiher.

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14 **IT IS SO ORDERED.**

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16 Dated: January 19, 2017



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NATHANAEL M. COUSINS
United States Magistrate Judge